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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1033-SS00355	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>May 16, 2006</u> Signature <u>Esther H. Yu</u> Typed or printed name <u>Esther H. Yu</u>		Application Number 10/702,132 Filed November 5, 2003 First Named Inventor Dennis D. Bicker Art Unit 2617 Examiner DESIR, Pierre Louis	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,342</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Jeffrey G. Toler</u> Typed or printed name <u>Jeffrey G. Toler</u> Telephone number <u>512-327-5515</u> Date <u>5-16-2006</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

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60533**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Dennis D. Bicker, et al.

Title: SYSTEM AND METHOD OF TRANSITIONING BETWEEN
CELLULAR AND VOICE OVER INTERNET PROTOCOL
COMMUNICATION

App. No.: 10/702,132

Filed: November 5, 2003

Examiner: DESIR, Pierre Louis

Group Art Unit: 2617

Atty. Dkt No.: 1033-SS00355

Confirmation No.: 6845

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action mailed on April 26, 2006 (hereinafter, "Final Office Action"), Applicants file herewith a Notice of Appeal and a Pre-Appeal Brief Request for Review. Applicants request review of the following issues.

Claims 1-2, 5-9, 11-13, and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moore, U.S. Pat. Pub. No. 2003/0039242 ("Moore"), in view of Ishidoshiro, U.S. Pat. Pub. No. 2004/0066776 ("Ishidoshiro"). Claims 3 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Ishidoshiro, and further in view of Reding, et al., U.S. Pat. Pub. No. 2004/0213212 ("Reding"). Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Ishidoshiro, and further in view of Shostak, U.S. Pat. Pub. No. 2004/0127241 ("Shostak"). Claims 14, 15 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reding in view of Moore and Ishidoshiro. Applicants respectfully traverse each rejection.

Applicants submit that the Final Office Action fails to establish a *prima facie* case of obviousness. Prima facie obviousness requires that "the alleged combination teach or suggest all

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the claim limitations.” *M.P.E.P.* §2142. The asserted combinations of Moore, Ishidoshiro, Reding and/or Shostak fail to disclose or suggest the particular arrangement of elements recited in the claims.

Independent claim 1 recites “sending a call forwarding message including the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network.” As stated in the Reply to the Non-Final Office Action mailed December 2, 2005, which is incorporated herein by reference, the combination of Moore and Ishidoshiro does not teach or suggest this element of claim 1.

The Final Office Action states that, “Moore does not specifically (although being obvious) a method comprising receiving an internet protocol address associated with the wireless local area network base station.” *Final Office Action*, p.2, 4th paragraph. If “although being obvious” was intended as a statement that the elements of claim 1 are implicitly disclosed by the reference, then Applicants respectfully request that the rejection be made clear and explicit. Merely implying that the reference implicitly discloses the elements of the claim is not sufficient to establish a prima facie case of obviousness. *See e.g.*, MPEP § 2112. Applicants, therefore, understand the statement to be an admission that Moore does not disclose a method comprising receiving an internet protocol address associated with the wireless local area network base station.

Ishidoshiro also does not disclose a method comprising receiving an internet protocol address associated with the wireless local area network base station. Ishidoshiro discloses a method including the radio IP telephone sending a terminal ID to the wireless LAN base station. *Ishidoshiro*, p.3, paragraph [0038]. The base station of Ishidoshiro “receives the terminal ID and sends the terminal ID and a base station ID, which is an identifier for identifying the base station, to the gatekeeper.” *Id.* The terminal ID does not correspond to an internet protocol address associated with the wireless local are network base station, as recited in claim 1, because the terminal ID is an identifier for the radio IP telephone, not for the base station. The base station ID of Ishidoshiro is not disclosed to be an internet protocol address.

Furthermore, neither Moore nor Ishidoshiro disclose or suggest sending a call forwarding message including the internet protocol address from the mobile phone to a remote cellular

network element of a wide area cellular network. The Final Office Action admits that Moore does not specifically disclose this element of claim 1. *Final Office Action*, p.5, 3rd paragraph. However, the Final Office Action states that Ishidoshiro discloses this element of claim 1 in that "the radio IP telephone set notifies the wireless LAN base station of a terminal ID, which includes IP address....The wireless LAN base station sends the terminal ID to the gatekeeper." *Final Office Action*, p. 6, 1st paragraph. Applicants respectfully submit that the recited steps of Ishidoshiro do not disclose or suggest sending a call forwarding message including the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network as recited in claim 1. For example, as quoted from the Final Office Action above, the terminal ID of Ishidoshiro is sent from the base station. Claim 1 recites sending...from the mobile phone. Furthermore, the terminal ID of Ishidoshiro is associated with the radio IP telephone. *Ishidoshiro*, p.3, paragraph [0038]. Claim 1 recites the internet protocol address associated with the wireless local area network base station.

Thus, the combination of Moore and Ishidoshiro, does not disclose or suggest each element of claim 1. The Final Office Action, therefore, fails to establish a prima facie case of obviousness with regard to claim 1. Additionally, since claims 2, 5-7 and 19-20 depend from claim 1, the combination of Moore and Ishidoshiro does not disclose or suggest each element of claims 2, 5-7 and 19-20.

Independent claim 8 recites retrieving an internet protocol address and an optional port number associated with the wireless local area network base station from a memory, and sending the internet protocol address and optional port number over a wireless fidelity communication link to the mobile phone. The combination of Moore and Ishidoshiro does not disclose or suggest this element of claim 8. The Final Office Action admits that Moore does not specifically disclose this element of claim 8. *Final Office Action*, p. 7, 4th paragraph. However, the Final Office Action asserts that "Ishidoshiro discloses a method comprising retrieving an internet protocol address and an optional port number (base station ID) associated with the wireless local area network base station from a memory (see page 3, paragraphs, 33, 38-40) and sending the internet protocol address and optional port number to the mobile phone over a wireless fidelity communication link." *Final Office Action*, p. 8, 1st paragraph. Applicants respectfully submit that, as previously stated, neither the terminal ID nor the base station ID of Ishidoshiro is an

internet protocol address associated with the wireless local area network base station, as recited in claim 8. Furthermore, the base station ID is not disclosed to be a port number, as recited in claim 8. Moreover, the base station ID is never disclosed to be sent to the radio IP telephone set of Ishidoshiro. Thus, even if the base station ID were an optional port number, Ishidoshiro still would not disclose or suggest sending the internet protocol address and optional port number over a wireless fidelity communication link to the mobile phone, as recited in claim 8.

Thus, the combination of Moore and Ishidoshiro, does not disclose or suggest each element of claim 8. The Final Office Action, therefore, fails to establish a prima facie case of obviousness with regard to claim 8. Additionally, since claims 9, 11-13 and 21 depend from claim 8, the combination of Moore and Ishidoshiro does not disclose or suggest each element of claims 9, 11-13 and 21.

Claim 14 recites a mobile phone device comprising a wide area cellular communication module that formulates a call forwarding message that includes the internet protocol address, the call forwarding message to be communicated to the remote wide area cellular network. The combination of Moore, Ishidoshiro and Reding does not disclose or suggest this element of claim 14. The Office Action admits that Reding does not specifically disclose this element of claim 14. *Final Office Action*, p.14, 2nd paragraph. Moore discloses a handset that sends a command to a mobile telephone network instructing the mobile telephone network to forward incoming calls to a specified telephone number. A handset that sends a command to forward calls to a specified telephone number does not disclose or suggest a mobile phone device comprising a wide area cellular communication module that formulates a call forwarding message that includes the internet protocol address, as recited in claim 14. The Final Office Action asserts that Ishidoshiro, at page 3-4, paragraphs 38-40, discloses a handset wherein a message is formulated that includes the internet protocol address. Applicants respectfully disagree. In fact, Ishidoshiro discloses the base station sending the terminal ID and the base station ID to the gatekeeper. *Ishidoshiro*, p. 3, paragraph [0038]. The base station receives the terminal ID from the radio IP telephone set; therefore, the base station must formulate the message to the gatekeeper that included the terminal ID and the base station ID. Thus, the radio IP handset of Ishidoshiro does not disclose or suggest this element of claim 14.

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The asserted combination of Moore, Ishidoshiro, and Reding therefore, fails to establish a prima facie case of obviousness with regard to claim 14. Additionally, claims 15 and 18 depend from claim 14. Since the combination of Moore, Ishidoshiro and Reding does not disclose or suggest each element of claim 14, the combination also does not disclose or suggest each element of claims 15 and 18.

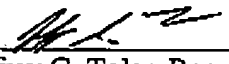
Claims 3 and 4 depend from claim 1. Likewise, claim 10 depends from claim 8 and includes each element of claim 8. In rejecting claims 3, 4 and 8 the Final Office Action relies on the combination of Moore and Ishidoshiro to disclose the elements of claims 3 and 4 which are derived from claims 1 and 8. The Final Office Action asserts only that Reding or Shostak disclose elements present in claims 3, 4 and 10 that are not present in claims 1 or 8. Neither Reding nor Shostak remedy the deficiencies with the combination of Moore and Ishidoshiro with regard to the elements of claims 1 and 8, as discussed above. Therefore, the asserted combinations of Moore and Ishidoshiro with Reding or Shostak do not disclose or suggest each of the elements of claims 3, 4 and 10, at least in light of their dependency from claim 1 or claim 8.

CONCLUSION

In light of the arguments presented above, the rejections of claims 1-15 and 18-21 are improper, and the Applicants respectfully request withdrawal of the rejections. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

5-16-2006
Date


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